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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,371	03/12/2004	Bernard Kasser	00RO10154377	6357
27975 7590 05/11/2009 ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791				
EXAMINER BAYOU, YONAS A				
ART UNIT 2434		PAPER NUMBER		
NOTIFICATION DATE 05/11/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

creganoa@addmg.com

### Office Action Summary

**Application No.**

10/799,371

**Applicant(s)**

KASSER, BERNARD

**Examiner**

YONAS BAYOU

**Art Unit**

2434

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 7, 9-10, 12, 14, 17-18, 20, 25-26 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 3, 5-6, 8, 11, 13, 15-16, 19, 21-24, 27-28 and 33-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to applicant's response filed on 02/23/2009.
2. Claims 1-28 and 30-34 are pending.
3. Claim 29 is cancelled.
4. Applicant's arguments have been fully considered but they are not persuasive.
5. When responding to the Office action, Applicant is advised to clearly point out the patentable novelty the claims present in view of the state of the art disclosed by the reference(s) cited or the objection made. A showing of how the amendments avoid such references or objections must also be present. See 37 C.F.R. 1.111(c).

### **Response to Arguments**

1. Applicant, on pages 16-18, second paragraph of page 19 and page 20 of the remarks, has only described interpretation of the invention and on page 9, first paragraph of the remarks, applicant argues: "Harada et al. and Chatani et al. both fail to disclose that the server receives the identification information of the storage device."

Examiner respectfully disagrees and asserts that Chatani teaches server and client computer systems transmit and receive data over a computer network or standard telephone line. The steps of accessing, downloading, and manipulating the data, as well as other aspects of the present invention are implemented by central processing units (CPU) in the server and client computers executing sequences of instructions stored in

a memory [para. 16, lines 4-9]. The instructions may be loaded into the memory of the server or client computers from a storage device or from one or more other computer systems over a network connection [para. 2, lines 1-7]. The software product distribution scheme utilizes an aspect in which the good that is purchased by the user is not necessarily the product media itself, but rather a key that can be used to unlock the program stored on the media. Identification information transmitted by the user is used by the server to generate the unlock key used by the user [para. 58, lines 1-7 and fig. 1; ID information associated with the media, e.g., a CD disk ID number received by the server helps to unlock the program/make the distribution of media more secure].

2. Examiner, however, in light of the above submission maintains the previous rejections while considering the amendments to the claims as follows:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4, 7, 9-10, 12, 14, 17-18, 20, 25-26 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al., Patent No.: US 6,581,160 B1 in view of Chatani et al., Pub. No. US 2002/0104019 A1.

Referring to claims 1, 9, 17, 25-26 and 31, Harada teaches a method for securing circulation of an encrypted digital document to be reproduced with a document reader, the method comprising:

providing a user with a storage device (smart card) storing identification information identifying the storage device **[figs. 1-2;** a storage device has inherently an ID, see item 13] and for storing an identification information list comprising identification information identifying recent document readers previously operated the storage device **[abstract, 5:40-48, 9:29-39 and fig. 2;** RLE 41 issues new revocation information including identification information for that electronic appliance corresponding to identifying recent document readers].

determining possible fraudulent use of the storage device based upon the information list that is transmitted to the server, the server comparing the identification information in the information list with an authorized or fraudulent document reader list for determining fraudulent use of the storage device **[abstract, 7:12-46 and figs. 1-2];**

if the storage device is not being fraudulently used, then transmitting over the digital data transmission network from the server to the computer terminal a decryption key specific to the digital document to be reproduced, with the decryption key being stored in the storage device **[abstract, 13:49-59 and fig. 10];**

decrypting the digital document using the stored decryption key by the document reader connected to the storage device **[6:56-63 and fig. 2];** and

reproducing the digital document decrypted by the document reader [7:12-18]. Harada does not appear to explicitly teach transmitting to a server over a digital data transmission network from the storage device to the server upon connection of the storage device to the server by a terminal connected to the digital data transmission network and to the storage device;

identifying from the server the storage device on the basis of the information identification of the storage device transmitted to the server. However Chatani teaches server and client computer systems transmit and receive data over a computer network or standard telephone line. The steps of accessing, downloading, and manipulating the data, as well as other aspects of the present invention are implemented by central processing units (CPU) in the server and client computers executing sequences of instructions stored in a memory [para. 16, lines 4-9]. The instructions may be loaded into the memory of the server or client computers from a storage device or from one or more other computer systems over a network connection. For example, a client computer may transmit a sequence of instructions to the server computer in response to a message transmitted to the client over a network by the server [para. 2, lines 1-7]. The software product distribution scheme utilizes an aspect in which the good that is purchased by the user is not necessarily the product media itself, but rather a key that can be used to unlock the program stored on the media. Identification information transmitted by the user is used by the server to generate the unlock key used by the user [para. 58, lines 1-7 and fig. 1]. Harada and Chatani are analogous art because both teach securing distribution of encoded digital data/digital documents.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the method of Harada to include server and client computer systems transmit and receive data over a computer network of Chatani because Identification information transmitted by the user is used by the server to generate the unlock key used by the user [para. 58, lines 1-7 and fig. 1], please see KSR International Co. v. Teleflex Inc., 550 U.S., 82 USPQ2d 1385 (2007) for further interpretation.

Referring to claims 2, 10 and 18, Harada teaches the method for secure distribution of digital document, wherein the decryption key is transmitted from the storage device to the document reader only if the document reader is authorized **[abstract, 13:49-59 and fig. 10]**.

Referring to claims 4, 12, 20 and 30, Harada teaches the method for secure distribution of digital document, wherein the information list also identifies unauthorized document readers; and wherein fraudulent use of the storage device is also determined if the identification information associated with the document reader is on the information list **[abstract, 7:12-46 and figs. 1-2]**.

Referring to claim 7, Harada as modified teaches the method for secure distribution of digital document, wherein if the storage device is being fraudulently used, then the server deactivates the storage device over the digital data transmission network for prohibiting any further use of the storage device for reproducing a digital

document [Chatani; page 7, paragraph 0058, lines 21-30; if the storage device is not fraudulent/authorized, inherently the identification information stored in the storage device has to be associated with the document reader so that it can be played/reproduced].

Referring to claims 14 and 32, Harada as modified teaches the method for secure distribution of digital document, wherein if the storage device is being fraudulently used, then the decryption key is not transmitted over the digital data transmission network from the server to the storage device [Chatani; page 8, paragraph 0063; inherently transmit the unlock key/decryption key from the server to the user if the user is authorized over a transmission network].

***Allowable Subject Matter***

1. Claims 3, 5-6, 8, 11, 13, 15-16, 19, 21-24, 27-28 and 33-34 are objected to as allowable subject matter if incorporated into independent claims including all intervening claims.

Independent claims 1 and 9 have conditional statement "if", and both conditions have to be present in the claim in order for applicant arguments to be persuasive.

For that reason examiner has pointed out to the claims 3, 5-6, 8, 11, 13, 15-16, 19, 21-24, 27-28 and 33-34 (see above).



Having only one conditional limitation in the claim would result no patentable weight to such conditional limitation since such condition may not be realized in a "if" statement.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YONAS BAYOU whose telephone number is (571)272-7610. The examiner can normally be reached on m-f,7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yonas Bayou/

Examiner, Art Unit 2434

05/05/2009

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434